

Docket No.: RPC 0529 PUSA

REMARKS

Claims 1-30 were pending. The Examiner has indicated that claims 17-24 are allowed and that claims 13-15 would be allowable if amended into independent form. Claims 6 and 29 are cancelled in this amendment. Claims 31-32 are new.

§102 rejections over Loftus (GB 2,353,012)

The Examiner has rejected claims 8-12 and 26 as anticipated by Loftus (GB 2,353,012). The Examiner calls the projections 58 of Loftus the claimed "top locking portion." However, claim 8 recites that "each tray side wall has a top locking portion." First, the projections 58 are not formed on "tray side walls," but are formed on the lid of the tray. Second, the projections 58 are not formed on each of two, opposed side walls, but are only at one end of the lid, as can be seen in Figure 5 of Loftus (it is apparent that the illustration of two pair of projections 58 in Figure 4a is in error, since it would not work, both because the recesses 52 are formed in only one wall and because the horizontal projections 58 could not be slid into the recesses 52 if there were two sets of projections 58 at opposite ends of the lids).

Similarly, the recesses 52 (which the Examiner calls the claimed "bottom locking portions") are not formed on each of a pair of opposed tray side walls, as claimed. Loftus states that the recesses are formed on one of the side walls (page 3, second paragraph). Therefore, these claims are not anticipated by Loftus.

§102 rejections over Upshaw (US 4,298,127)

The Examiner has rejected claims 28-29 as anticipated by Upshaw (US 4,298,127). Claim 28 has been amended to incorporate the elements of claim 29. The basket of Upshaw is not supported on both the dolly surface and whatever the Examiner is calling the claimed "pair of opposed peripheral sides in a plane different from a plane of the upper surface." Claim 28 has also been amended to clarify the location of the peripheral sides.

§103 rejections over Upshaw

The Examiner has rejected claims 1-5, 7 and 25 as obvious over Upshaw. These claims recite that the protruding members extend into the openings but not beyond the tray upper floor surface. The flanges 206, 208 in Upshaw must be long enough to secure the wire basket to the dolly. There is no suggestion or motivation to shorten them so that they do not

extend beyond the upper floor surface. The case that the Examiner cites about "a change in size" (*In re Rose*, 105 USPQ 237 (CCPA 1955)) does not state that all changes in size are obvious. The Court in *Rose* was considering an invention for stacking lumber in bundles large enough to require a lift truck, as distinguished from bundles that could be lifted by hand. Thus, the Court in *Rose* held only that it would be obvious to apply the known principles in stacking small bundles to the process of stacking large bundles. Additionally, *Rose* was long before *Graham v. John Deere*, 383 U.S. 1 (1966) which reshaped the test for obviousness to a more objective test. It is well established now that there must be some motivation or suggestion for making the proposed modification. More particularly, the Federal Circuit has made clear that "if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2143.01. In this case, the flanges 206, 208 could not be made shorter than or the same as the thickness of the wires of the wire basket and still retain the basket on the dolly. That modification would make the Upshaw dolly wholly unsatisfactory. This common sense conclusion is further evidenced by just how very long those flanges 206, 208 are compared to the wires. Not only must they protrude upward from the wires, they must protrude a great deal beyond the wires.

The Examiner's proposed motivation for this change is the possibility of moving the flanges 206, 208 to the center of the dolly, in which case shortening the flanges 206, 208 would prevent interference with the goods in the basket. However, there is no motivation or suggestion for moving the flanges 206, 208 to the center of the dolly in the first place. In fact, this would not be possible in the Upshaw design because the center of the dolly is completely open - - there is nowhere to mount the flanges 206, 208 in the center of the dolly.

Therefore there is no motivation for the proposed shortening of the flanges 206, 208 and claims 1-5, 7 and 25 are not obvious.

§103 rejections over Upshaw and Cino (U.S. 6,105,980)

The Examiner has rejected claims 27 and 30 as obvious over Upshaw in view of Cino. Claims 27 and 30 recite casters and caster pockets on the dolly floor. As the Examiner admits, the dolly in Upshaw does not disclose caster pockets. Nor could caster pockets be added to Upshaw because the Upshaw dollies cannot be stacked on like dollies because the flanges 206, 208 are too long and would interfere with a stacked dolly. The Examiner has stated that it would be obvious to modify Upshaw to include the caster pockets of Cino;

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however, Cino teaches that it is beneficial to have a dolly without a dolly floor, so that only the boxes specifically designed for that dolly will work with that dolly. (col. 1, lines 29-36). Therefore, since Cino does not have a dolly floor (and teaches against it), there are no caster pockets in a dolly floor as required by claim 36. Even if Upshaw were modified to include this feature of Cino, the "caster pockets" (as the Examiner calls them) would be outside the dolly floor, and would be outside an area where the tray floor would partially (claim 27) or completely (claim 31) cover them. Therefore, claim 27, 30 and 31 are independently patentable.

Conclusion

Reconsideration of the Application is requested. Please charge \$110 for a one-month extension and \$86 for one additional independent claim to Deposit Account No. 50-1984. If any additional fees are due please charge all fees to Deposit Account No. 50-1984.

Respectfully submitted,



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